

Appl. No.: 10/627,504
Art Unit: 1712 Docket No.: B03-50
Reply to Final Office Action of August 5, 2005

REMARKS

Claims 1-20 and 22-26 appear in this application for the Examiner's review and consideration. Claims 1, 25, and 26 has been amended to narrow R₁ of the benzoate structure to include only hydroxyalkylether, alkyl, and hydroxyphenyl (removing alkylphenyl and phenyl).

Claim 21 has been cancelled.

No new matter has been added by these amendments.

Rejection Under 35 U.S.C. § 112, Second Paragraph

Claim 21 was rejected under 35 U.S.C. § 112, second paragraph. Claim 21 has been cancelled, rendering the rejection moot. The rejection under 35 U.S.C. § 112, second paragraph, is, therefore, believed to have been overcome. Applicants respectfully request reconsideration and withdrawal thereof.

Rejection Under 35 U.S.C. § 103(a)

Claims 1-20, 24, and 26 were rejected under 35 U.S.C. § 103(a) as being obvious over Peter in view of Megna or Chu;

Claims 1-20, 22-24, and 26 were rejected under 35 U.S.C. § 103(a) as being obvious over Dewanjee in view of Megna or Chu;

Claim 21 was rejected under 35 U.S.C. § 103(a) as being obvious over Peter in view of Speelman; and

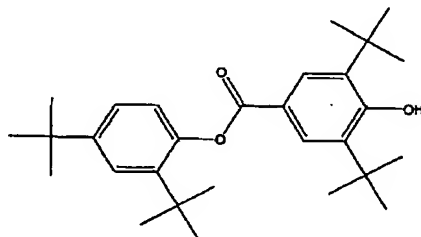
Claim 21 was rejected under 35 U.S.C. § 103(a) as being obvious over Dewanjee in view of Speelman.

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation to modify the reference or combine the teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must be found in the prior art, not in Applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 493, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991).

The combination of references cited do not disclose or even suggest, a UV stabilizer comprising a benzoate having the formula with the specific R₁ groups, as now recited in claims

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1, 25, and 26 of the present invention. The Examiner refers Applicants to Tinuvin® 120 disclosed in Megna and Chu as a benzoate stabilizer for use in the golf ball of Peter or Dewanjee. The chemical structure of Tinuvin® 120 (also known as AM-340), which has the chemical name 2,4-di-tert-butylphenyl-3,5-di-tert-butyl-4-hydroxybenzoate, is presented below:



Tinuvin® 120

Tinuvin® 120 (AM-340) contains a phenyl ring in what would be the 'R₁' position of its structure. The phenyl ring is not a hydroxyalkylether, alkyl, or hydroxyphenyl group, as now recited in claims 1, 25, and 26 of the present invention. For at least this reason, the rejections under 35 U.S.C. § 103(a) is believed to have been overcome. Applicants respectfully request reconsideration and withdrawal thereof.

Obviousness-Type Double Patenting

Claims 1-26 were rejected under the judicially-created doctrine of obviousness type double patenting over claims 1-26 of co-pending U.S. Patent Application No. 10/384,422. Applicants respectfully traverse the rejection but, in an effort to further prosecution of the above-captioned application, would consider filing a terminal disclaimer, if appropriate, once either the instant application or the '422 application is allowed and the scope of their respective claims is determined.

CONCLUSION

Based on the remarks set forth above, Applicants believe that all of the rejections have been overcome and the claims of the subject application are in condition for allowance. Should the Examiner have any further concerns or believe that a discussion with the Applicants' attorney


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would further the prosecution of this application, the Examiner is encouraged to call the attorney at the number below.

No fee is believed to be due for this submission. Should any other required fees be due, however, please charge them to Acushnet Company Deposit Account No. 502309.

Respectfully submitted,

Date: October 5, 2005



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